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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,461	06/10/1999	HERMAN RODRIGUEZ	AT9-99-085	8120
35525	7590	10/12/2004	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			NGUYEN, CUONG H	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/329,461

Applicant(s)

RODRIGUEZ ET AL.

Examiner

CUONG H. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3,4,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4,27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Status of the Claims**

1. Claims 3-4, 27-28 are pending based on the amendment dated 4/08/2003.

**Response to Applicant's Arguments**

2. In response to applicants' arguments regarding the reference to Tognazzini, the examiner agrees that Tognazzini is primarily concerned with providing digital signatures via email to the customer and reporting/tracking expenses. However, Trotta, Jr. (US Pat. 5,595,264) creates an environment for Tognazzini. Therefore the claims' limitations read on a combination of teachings from Trotta, Jr and Tognazzini. Applicants also argue that the instant invention is claiming "a specific arrangement" of steps "that provide advantages that were not previously available". Trotta, Jr. and Tognazzini teach claimed arrangement of steps. Moreover, it is the examiner's position that Tognazzini suggests "updating an inventory" by producing reports that summarize some of the electronic receipt transactions (col. 6, lines 55-67; col. 2, lines 64 and 65). By formulating an expense report and updating accounting records as disclosed by Tognazzini in col. 2, lines 64 and 65, an inventory of the transaction activity/history is inherently accomplished.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

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*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

3. Claim 3-4, 27-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Trotta, Jr. (US Pat. 5,595,264) in view of Tognazzini (US Pat. 5,739,512).

A. Regarding claims 3 and 4, Trotta, Jr. suggests a method for processing an electronic receipt by maintaining inventory records of product being sold (see Trotta, Jr. Fig.1, ref. 38, and claim 3), Tognazzini also teaches a method for processing electronic receipt for travel services (i.e. hotel, restaurant and rental car), using a computer which includes processing a purchase transaction (see Tognazzini col. 3, lines claim 5-11), generating an electronic receipt comprising data concerning the purchase transaction (see Tognazzini, Fig.1 ref. 100, col. 3, lines 21-26; col. 3, lines 34-36), storing and reading the electronic receipt on a movable storage medium (col. 3, lines 39-44 where "removable storage medium" equates to "computer program products" as taught by Tognazzini), validating the electronic receipt using a digital signature which is inspected for authenticity and integrity (see Tognazzini, col. 5, lines 1-10), and in response to validating the e-receipt, providing an indication to proceed with delivery of goods or services related to the purchase

transaction (see Tognazzini, col. 2, lines 35-40 i.e. the account is "debit(ed)" for the service), and updating an inventory affected by said delivery of goods or services (see Tognazzini, col. 6, lines 55-67; col. 2, lines 64-65, and 3:4-20, which disclose producing a report summarizing some of the receipts i.e. updating an inventory of activity).

B. Regarding claims 27 and 28, Tognazzini further teaches a computer program product in a computer readable medium (see Tognazzini, col. 3, lines 39-45) for processing an electronic receipt (see Tognazzini, col. 2, lines 17-67). It is obvious that Tognazzini uses computer instructions to direct the computer to perform all of the actions/steps identified *supra*, and as specifically claimed in claims 27 and 28.

It would have been obvious for a combination of Trotta Jr. and Tognazzini to provide updated inventory in transactions using e-receipts for goods presented by Tognazzini because a validated digital receipt would provide accurate information that a product already received by a customer, and it is proper to take into account (providing updated inventory) of that fact to both a seller, and a buyer.

#### **Conclusion**

4. Claims 3-4, 27-28 are not patentable. Accordingly, THIS ACTION IS MADE FINAL because it necessitates a new ground(s)

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of rejection. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. These references are considered pertinent to this application:

- Business Wire, Feb 11, 1999; RPK Security Selected to Provide Encryption Solution for Electronic Payment Systems and Smart Card Readers. (claim 46)
- Digital signature reaches new level.(Bank of Nova Scotia uses Entrust Technologies' public key infrastructure software) (Company Operations); (Author: Greg Meckbach. Issue: June 22, 1998).
- **Trotta**, Jr., (US Pat. 5,595,264), System and method for automated shopping - 1/21/1997; wherein a system and method

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of automated shopping, including a portable bar code scanner for scanning bar code indicia information on items selected to be purchased, securing the scanner in a holder for limited access, and releasing the portable bar code scanner upon receiving an authorized payment card. A plurality of items for purchase are displayed in a store such that a customer can select an item to be purchased from the store display. The customer scans the bar code indicia on the selected item from the store display. The payment card is debited for the purchase price of the selected item and then returned to the customer.

- **Kitagawa** et al. (US Pat. 6,032,857 - 8/23/1994) Electronic money system wherein an electronic money system has an IC card for electronic money having a memory for maintaining money deposit and money debit information and another memory, such as an EPROM, for storing transaction data, including detailed information of transactions, such as the content of a typical receipt received from a retail store. The transaction information can be used at a later time in a personal computer so that an electronic record of household expenses can be maintained. The transaction data that is stored includes the product name, price of the product, quantity of the product purchased and similar details of the transaction. The IC card memory can record the name and telephone number of a retail store where the card has been

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used or a network address can be recorded in the memory for use by a customer to access electronic direct-mail information by using a PC. Also, a store can determine whether a particular purchase is within a range of average purchases in terms of the number of products being purchased in a transaction and the total cost of the transaction, based on the stored transaction information.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687/703-746-5572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Cuong H. Nguyen*

*CHN*  
CUONG H. NGUYEN  
Primary Examiner  
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